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NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			LIANG, GWEN	
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			2162	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TH

Office Action Summary	Application No.	Applicant(s)	
	10/089,794	KROHN ET AL.	
	Examiner	Art Unit	
	GWEN LIANG	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09122005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications through the applicant's amendment, filed on 08/09/2005.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract exceeds 150 words. Please fix it according to the guidance stated above.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13, 14, 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

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A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Independent claim 13 in view of the above-cited MPEP sections, are not statutory because the process of providing an information retrieval tool output to a user-input search criterion ... merely provides the output to search criterion without producing any tangible result and/or being limited to a practical application within the technological arts.

Claim 13 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by the written description for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In independent claims 13 and 15, the claimed subject matter "providing an information retrieval tool output to a user-input search criterion using said store of weighted search criteria" is not is not sufficiently supported by the teaching in the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 14 and 16, the claimed limitation "thresholded determination of applicability" renders the claim indefinite because it's meaning is unclear to one having ordinary skill in the art. Firstly the word "thresholded" is not a recognized word in the dictionary. Secondly, the term "applicability" is too broad in scope for a person of ordinary skill in the art to understand what applicability the claim language is referring to. Therefore the claim limitation is indefinite.

Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multi-form Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5, 7, 9, 12, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liddy et al., "Liddy" (U.S. Patent No. 5,963,940), and further in view of Ozawa et al., "Ozawa" (JP Patent No. 7-271798).

With respect to claim 7, Liddy discloses a method ...comprising:

(i) detecting submission by a user of a search criterion to an information retrieval tool, and a corresponding response from the retrieval tool (Abstract, "The user enters a query and the system processes the query to generate an alternative representation..."; "After processing the query, the system displays query information to the user, indicating the system's interpretation and representation of the content of the query. The user is then given an opportunity to provide input, in response to which the system modifies the alternative representation of the query. Once the user has provided desired input, the possibly modified representation of the query is matched to the relevant document database, and measures of relevance generated for the documents. A set of documents is presented to the user..."; col. 32, lines 46-48, "Matcher 55 takes the QP-based query representation, either unmodified or modified by the user as described above, and finds suitably similar documents in a range of databases.");

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(ii) detecting an indication by the user as to the relevance of a set of information identified in the response from the retrieval tool (Abstract, "A set of documents is presented to the user, who is given an opportunity to select some or all of the documents, typically on the basis of such documents being of particular relevance");

(iii) storing a reference to the set of information indicated as being relevant at step (ii) (col. 27, line 67 – col. 28, line 6, "...a number occur after the documents are retrieved (including retrieval and display criteria selection, the display of relevant documents in various formats, the marking of relevant documents, the construction of new, informed queries based on the contents of documents deemed highly relevant, and printing or storing marked documents..."), and a record of the search criterion submitted by the user at step (i) (col. 32, lines 43-45, 'The user can also click the "Return to Request" button 370i and modify the query' wherein it is inherent that the query is stored in the system for the user to be able to go back to modify the query, wherein 'query' is analogous to 'search criterion');

(vi) providing an information retrieval tool search result output obtained by use of search criteria (col. 7 lines 35-46, "User interface software 70 allows the user to interact with the system. The user interface software is responsible for accepting queries, which it provides to processing engine 50. The user interface software also provides feedback to the user regarding the system's interpretation of the query, and accepts responsive feedback from the user in order to reformulate the query. The user interface software also presents the retrieved documents as a result of the query to the user and reformats the output in response to user input. User interface software 70 is preferably

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implemented as a graphical user interface (GUI), and will often be referred to as the GUI”).

However Liddy does not explicitly disclose selecting... and calculating, for each search criterion... a weighting indicative of the proportion of users who identified the selected set of information and indicated that it was relevant; identifying... a recorded search criterion having... a weighting in excess of a predetermined threshold, and use of said identified search criterion.

Ozawa discloses the steps of:

(iv) selecting one or more: sets of information referenced in the store and calculating, for each search criterion recorded in respect of each of said one or more selected sets of information, a weighting indicative of the proportion of users who, on submitting the search criterion to the information retrieval tool, identified the selected set of information and indicated that it was relevant (page 8, section [0009], “The merits of retrieval efficiency of multiple information retrieval techniques are judged by calculating one retrieval efficiency value for each retrieval technique...”, wherein the retrieval efficiency value is analogous to the weighting as claimed; “...an information retrieval technique evaluation method is proposed such that when the aforementioned data evaluation value is calculated, the actual evaluation value is calculated from the number of people on the minority side and the number of people on the majority side of the external evaluation value according to a predetermined formula”, wherein the “majority” and the “minority” of people are indicative of “proportion of users”; page 16, “it is judged whether to be data that should be retrieved or data that should not be retrieved from the

ratio of the number of people that think it should be retrieved and the number of people that think it should not be retrieved in relational judgment module”, wherein the proportion of people is indicated by ratio of the number of people providing judgment);

(v) identifying, in respect of said one or more selected sets of information from step (iv), a recorded search criterion having, in respect of each said selected set of information, a weighting in excess of a predetermined threshold (pages 9-10, section [0012], wherein an order calculation means that calculates the respective order of each retrieval technique; pages 10-11, section [0014], wherein the retrieval efficiency is represented using one index. By sequencing the valuation values calculated for at least one or more information retrieval techniques, the merits of each type of information retrieval technique are determined; page 15, section [0030], “Of these input data, the table of information retrieval technique retrieval results, as shown in Figure 3, is composed of a technique number for the retrieval technique, an identifier that represents the set of each retrieval condition and each datum in the database, and a judgment flag that represents whether or not said retrieval technique should retrieve the set represented by each identifier”; page 25, section [0063], “sorting module (74) that arranges and outputs the order value calculated for each retrieval technique in order from the smallest”; pages 16-17, section [0034], wherein a threshold can be set before data retrieval); and

(vi) use of said identified search criterion (page 15, section [0030]; page 25, section [0063]; page 5, pages 16-17, section [0034]; page 5, section [0001], “This invention relates to an information retrieval technique evaluation method and device for

same for automatically selecting the optimal information retrieval technique when multiple information retrieval techniques are available. In particular, it relates to an evaluation method and device for a database retrieval technique where the relationship between retrieval conditions and data that should be retrieved changes often according to [the needs of the] user, as represented by a current events information database, such as for newspaper articles”, wherein each retrieval technique contains multiple retrieval conditions, each individually evaluated as illustrated in Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a method of calculating a weighting indicative of the proportion of users who ... identified the selected set of information and indicated that it was relevant as disclosed in Ozawa into the method of accessing sets of information as disclosed by Liddy to provide a determination means that compares the number of people that think something should be retrieved counted by said counting means and the number of people that think it should not be retrieved, and that determines that said data to be retrieved should be retrieved when the number of people that think it should be retrieved is at or above a predetermined ratio (page 9, lines 9-12) and it is obvious to use said identified search criterion as disclosed by Ozawa to obtain the information retrieval tool search result output as disclosed in Liddy for automatically selecting the optimal information retrieval technique (page 5, section [0001]) . One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

Claim 9 is rejected for the reasons set forth hereinabove for claim 7 and furthermore Liddy discloses a method wherein, at step (ii), said indication comprises accessing a set of information identified in the response from the retrieval tool (Abstract).

The subject matter of claim 1 is rejected in the analysis above for claim 7, and furthermore Liddy and Ozawa discloses an apparatus having:

a computer having a user interface providing access to at least one information retrieval tool (Liddy , col. 4, lines 13-15, "FIG. 8 is a screen shot showing the general features common to most screens used in the graphic user interface (GUI)"; col. 7, lines 35-46, "User interface software 70 allows the user to interact with the system. The user interface software is responsible for accepting queries, which it provides to processing engine 50. The user interface software also presents the retrieved documents as a result of the query to the user and reformats the output in response to user input. User interface software 70 is preferably implemented as a graphical user interface (GUI), and will often be referred to as the GUI");

a computer store for recording data relating to information retrieval by users (Liddy , col. 6, lines 60-67, "The server's storage subsystem 35, as shown in FIG. 1, maintains the basic programming and data constructs that provide the functionality of the DR-LINK system. DR-LINK software is designed to (1) process text stored in digital form (documents) or entered in digital form on a computer terminal (queries) to create a database file recording the manifold contents of the text, and (2) match discrete texts

(documents) to the requirements of a user's query text.”; also see Ozawa, page 31, description of Figure 3).

The subject matter of claims 2 and 3 is rejected in the analysis above for claims 7 and 9, and therefore these claims are rejected on that basis.

Claim 5 is rejected for the reasons set forth hereinabove for claim 1 and furthermore Liddy discloses an apparatus wherein said search criteria include words or word phrases and wherein said monitoring means are operable to record words from said one or more search criteria in a stemmed form (col. 5, lines 8-15).

Claim 12 is rejected for the reasons set forth hereinabove for claim 1 and furthermore Liddy discloses an apparatus wherein said group comprises at least one set of information representative of a particular category of information (Figure 16).

With respect to claim 13, Liddy discloses a method ...comprising:

for each of plural items of stored information, maintaining a store of search criteria previously used by plural users (col. 32, lines 43-45, ‘The user can also click the "Return to Request" button 370i and modify the query’ wherein it is inherent that the query is stored in the system for the user to be able to go back to modify the query, wherein ‘query’ is analogous to ‘search criterion’) and

providing an information retrieval tool output to a user-input search criterion using said store of weighted search criteria (col. 7 lines 35-46, “User interface software 70

allows the user to interact with the system. The user interface software is responsible for accepting queries, which it provides to processing engine 50. The user interface software also provides feedback to the user regarding the system's interpretation of the query, and accepts responsive feedback from the user in order to reformulate the query. The user interface software also presents the retrieved documents as a result of the query to the user and reformats the output in response to user input. User interface software 70 is preferably implemented as a graphical user interface (GUI), and will often be referred to as the GUI").

However Liddy does not explicitly disclose search criteria individually weighted to represent the proportion of prior users who are considered to have found a respectively associated stored item of information to be relevant to a particular search criterion, nor use of said store of weighted search criteria.

Ozawa discloses limitations of:

a store of search criteria individually weighted to represent the proportion of prior users who are considered to have found a respectively associated stored item of information to be relevant to a particular search criterion (page 18, section [0038], "The processing between step 13 to step 18 if performed for all given retrieval techniques. When it is determined that processing for all given retrieval techniques is completed at step 18-1, the retrieval technique number and evaluation value are stored in evaluation value buffer (7), and they are rearranged in order of smaller evaluation value in sorting module (8) as step 19"; page 8, section [0009], "The merits of retrieval efficiency of multiple information retrieval techniques are judged by calculating one retrieval

efficiency value for each retrieval technique...”, wherein the retrieval efficiency value is analogous to the weighting as claimed; “...an information retrieval technique evaluation method is proposed such that when the aforementioned data evaluation value is calculated, the actual evaluation value is calculated from the number of people on the minority side and the number of people on the majority side of the external evaluation value according to a predetermined formula”, wherein the “majority” and the “minority” of people are indicative of “proportion of users”; page 16, “it is judged whether to be data that should be retrieved or data that should not be retrieved from the ratio of the number of people that think it should be retrieved and the number of people that think it should not be retrieved in relational judgment module”, wherein the proportion of people is indicated by ratio of the number of people providing judgment; See also Figure 3); and use of said store of weighted search criteria (page 8, section [0009], “The merits of retrieval efficiency of multiple information retrieval techniques are judged by calculating one retrieval efficiency value for each retrieval technique...”, wherein the retrieval efficiency value is analogous to the weighting as claimed; page 15, section [0030]; page 25, section [0063]; page 5, pages 16-17, section [0034]; page 5, section [0001], “This invention relates to an information retrieval technique evaluation method and device for same for automatically selecting the optimal information retrieval technique when multiple information retrieval techniques are available. In particular, it relates to an evaluation method and device for a database retrieval technique where the relationship between retrieval conditions and data that should be retrieved changes often according to [the needs of the] user, as represented by a current events

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information database, such as for newspaper articles", wherein each retrieval technique contains multiple retrieval conditions, each individually evaluated as illustrated in Figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a store of search criteria individually weighted to represent the proportion of prior users who are considered to have found a respectively associated stored item of information to be relevant to a particular search criterion as disclosed in Ozawa into the store of search criteria as disclosed by Liddy to provide a determination means that compares the number of people that think something should be retrieved counted by said counting means and the number of people that think it should not be retrieved, and that determines that said data to be retrieved should be retrieved when the number of people that think it should be retrieved is at or above a predetermined ratio (page 9, lines 9-12) and it is obvious to use said store of weighted search criteria as disclosed by Ozawa to obtain the information retrieval tool search result output as disclosed in Liddy for automatically selecting the optimal information retrieval technique (page 5, section [0001]) . One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

Claims 14 and 16 are rejected for the reasons set forth hereinabove for claim 13 and furthermore Ozawa discloses a method wherein, said weighted criteria represent a binary-valued thresholded determination of applicability (pages 9-10, section [0012]; pages 10-11, section [0014],; page 15, section [0030]; page 25, section [0063]; pages

16-17, section [0034], wherein a threshold can be set before data retrieval; See also Figure 3).

Claim 15 is rejected on grounds corresponding to the reasons given above for claim 13.

10. Claims 4, 6, 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liddy et al., "Liddy" (U.S. Patent No. 5,963,940), further in view of Ozawa et al., "Ozawa" (JP Patent No. 7-271798), and further in view of Driscoll (U.S. Patent No. 5,642,502).

Claim 8 is rejected for the reasons set forth hereinabove for claim 7, and furthermore Liddy discloses a method wherein, at step (iv), each said selected set of information is representative of the same category of information (Figure 7). However the combination of Liddy and Ozawa does not explicitly disclose the step of using said identified search criterion ... to search for further sets of information in said category of information.

Driscoll discloses a method wherein the method includes the step: (vi) using said identified search criterion from step (v) to search for further sets of information in said category of information (Abstract, "A user reading and passing through this ranked list checks off which documents are relevant or not. Then the system automatically causes the original search query to be updated into a second search query which can include the same words, less words or different words than the first search query. Words in the second search query can have the same or different weights compared to

the first search query. The system automatically searches the text data base and creates a second group of documents, which as a minimum does not include at least one of the documents found in the first group. The second group can also be comprised of additional documents not found in the first group. The ranking of documents in the second group is different than the first ranking such that the more relevant documents are found closer to the top of the list”).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a step of using said identified search criterion from step (v) to search for further sets of information in said category of information as disclosed in Driscoll into the method of accessing sets of information as disclosed by the combination of Liddy and Ozawa to automatically search the text data base and create a second group of documents, which as a minimum does not include at least one of the documents found in the first group. The second group can also be comprised of additional documents not found in the first group (Abstract). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

Claim 10 is rejected for the reasons set forth hereinabove for claim 9. However the combination of Liddy and Ozawa does not explicitly disclose a method wherein, at step (ii), detecting said indication includes measuring the time spent by the user in accessing said set of information.

Driscoll discloses a method wherein, at step (ii), detecting said indication includes measuring the time spent by the user in accessing said set of information (col.

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10, lines 18-20, wherein it is obvious that the time spent by a user in data accessing is measured due to the disclosure of the time-saving feature).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a step of measuring the time spent by the user in accessing said set of information as disclosed in Driscoll into the method of accessing sets of information as disclosed by the combination of Liddy and Ozawa to provide features useful to user in saving time and enhancing the quality of the search (col. 10, lines 18-20). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

The subject matter of claims 4 and 6 is rejected in the analysis above for claims 7 and 8, and therefore these claims are rejected on that basis.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liddy et al., "Liddy" (U.S. Patent No. 5,963,940), further in view of Ozawa et al., "Ozawa" (JP Patent No. 7-271798), further in view of Driscoll (U.S. Patent No. 5,642,502), and further in view of Gray (U.S. Patent No. 5,758,335).

Claim 11 is rejected for the reasons set forth hereinabove for claim 10. However the combination of Liddy, Ozawa and Driscoll does not explicitly disclose a method wherein.. said weighting is adjusted according to the measurements of time spent by users in accessing the respective selected set of information.

Gray discloses a method wherein said weighting is adjusted according to the measurements of time spent by users in accessing the respective selected set of information (col. 2, lines 1-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a step of adjusting weighting according to the measurements of time spent by users in accessing the respective selected set of information as disclosed in Gray into the method of accessing sets of information as disclosed by the combination of Liddy, Ozawa and Driscoll because It is desirable to retrieve the data efficiently, as measured in terms of the time it takes to access the data using the I/O operation (col. 2, lines 1-5). One of ordinary skill in the art would be motivated to make the aforementioned combination with reasonable expectation of success.

Response to Arguments

12. Applicant's arguments regarding all pending have been fully considered but they are not persuasive.

Applicant's arguments regarding that Ozawa is trying to determine the optimal retrieval technique, based on feedback from users, which is different from the present invention where relevant search documents are determined by analyzing feedback based on specific search criterion, have been fully considered but they are not persuasive. As reasons stated for claim 7 in this office action, Ozawa teaches in page 15, section [0030], "Of these input data, the table of information retrieval technique retrieval results, as shown in Figure 3, is composed of a technique number for the

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retrieval technique, an identifier that represents the set of each retrieval condition and each datum in the database, and a judgment flag that represents whether or not said retrieval technique should retrieve the set represented by each identifier”; Ozawa teaches the retrieved information being identified by users as relevant in page 7 section [0008]. The user feedback is then analyzed based on each criterion as shown in Figure 3, wherein each retrieval technique may contain multiple retrieval conditions, each with a judgment flag showing the binary value of either “1” or “0”. Actually the teaching in Ozawa covers a broader range of invention, in which a retrieval technique is given an identifier, which further contains one or more conditions. Each condition is equivalent to the search criterion as claimed. In another word, if a retrieval technique contains only one condition, that retrieval technique reads on the search criterion as claimed in the applicant’s invention. Additional teaching to show that the user feedback is made based on each criterion can be found in Ozawa page 15, sections [0029] and [0030].

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (for example, “every document ... has a weighting associated with every search criterion” and “analyzing data according to each of the resulting search documents”) are not recited in the applicant’s claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant’s arguments regarding that Ozawa only looks at weightings for search techniques without consideration of individual search criteria, have been fully

considered but they are not persuasive. As reasons already stated above, the examiner regarded each retrieval technique taught in Ozawa is equivalent to a search criterion. In the dictionary *The Random House College Dictionary*), a criterion is defined as “an established rule or principle for testing anything. By this definition the retrieval technique, which contains retrieval conditions, read on the search criterion as claimed in the applicant's invention.

Applicant's arguments regarding that there is no suggestion in Ozawa of modifying the technique to come closer to the invention as here claimed because it is only concerned with improving searches by looking at and optimizing the retrieval technique used, whereas the claims at issue try to improve searches by looking at individual search criterion for each retrieved document, have been fully considered but they are not persuasive. The motivation of combining the prior art references as cited in this Office action is clearly stated in the Office action above.. The motivation to do what applicant has done, however, does not have to be the same as the applicant's to reach a conclusion of obviousness. See M.P.E.P. 2144. “Obviousness is not determined on the basis of purpose alone.” *In re Graf*, 343 F.2d 774, 777. 145 USPQ 197, 199 (CCPA 1965). “It is sufficient if the prior art clearly suggests doing what [applicants] have done, although the underlying explanation of exactly why this should be done, other than to obtain the expected superior beneficial results, is not taught or suggested in the cited references.” *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967). See also *In re Heck*, 699 F2d 1331, 1333, 216 USPQ 1038, 1040 (Fed. Cir. 1983). In summary, as long as there is some suggestion/motivation within the prior art to make

the modification or combination it does not have to be the same as the applicant's. The examiner maintains that all the pending claims are rejected as stated in this Office action.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GWEN LIANG whose telephone number is 571-272-4038. The examiner can normally be reached on 12:00 P.M. - 8:30 P.M. Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

19 September 2005
G.L.


Primary Examiner
Art Unit 2167